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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,297	12/08/2003	Jack W. Romano		2174
36220	7590	03/04/2005	EXAMINER	
JACK W. ROMANO/MEDINDICA-PAK, INC 13301 SE 79TH PLACE #A110 NEWCASTLE, WA 98059			BOGART, MICHAEL G	
			ART UNIT	PAPER NUMBER
			3761	

DATE MAILED: 03/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/730,297	ROMANO ET AL.
	Examiner Michael G. Bogart	Art Unit 3761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 08 December 2003.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-3 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) 1-3 is/are rejected.  
7)  Claim(s) \_\_\_\_\_ is/are objected to.  
8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 08 December 2003 is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 08 December 2003.  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_.

## DETAILED ACTION

### ***Claim Objections***

Claim 1 is objected to because of the following informalities:

In claim 1, lines 10 and 12, there are second and third recitations of “a lid”. From the context of the claim as a whole, it appears as if this is referring to the same lid recited in line 8. If this is the case, the second recitation of “a lid” should be referred as “said lid” to clarify this. Alternatively, if a second or third lid is what applicants intend to claim, then “a second lid”, “third lid”, etc. should be used.

In line 11, there is also a second recitation of “a delivery container”, (see line 9). The same objection discussed in the preceding paragraph applies here.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 are rejected under 35 U.S.C. § 102(b) as being anticipated by Rochat (US 5,269,924 A).

Regarding claim 1, Rochat teaches an apparatus for reducing supplies and waste comprising:

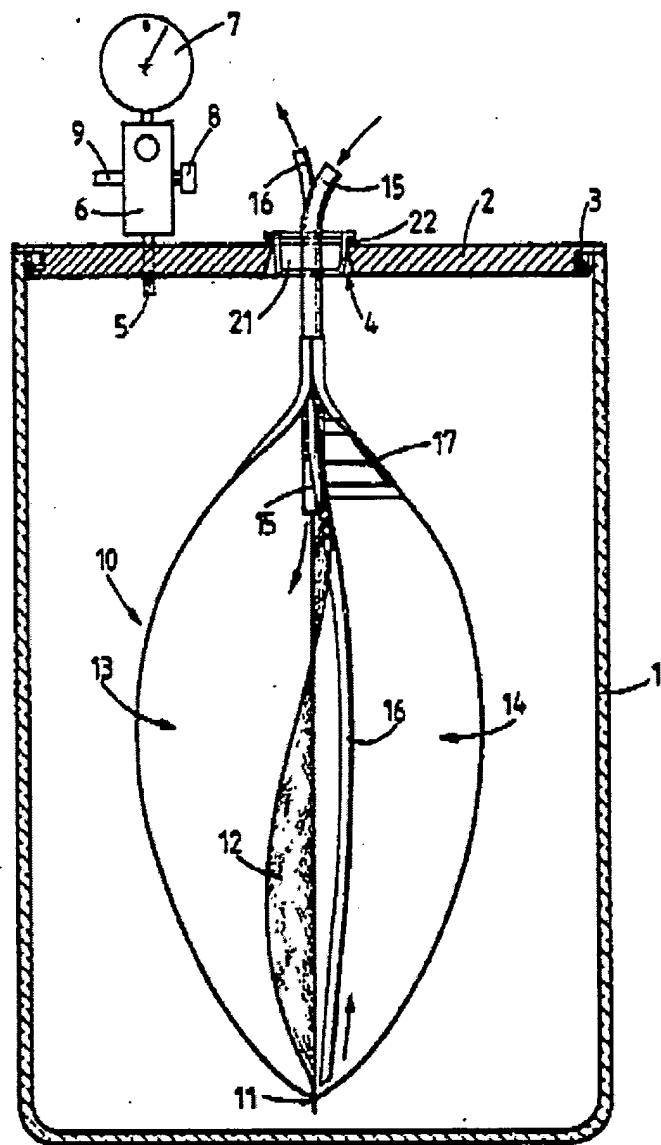
- a) a composite draw path (10, 15, 16) interposed between a vacuum source and a waste material site,
- b) a force emanating from said vacuum source to draw material from a waste sight,
- c) a canister (1) sized for sealing apposition with a lid (2),
- d) a throat/aperture plug (21) directing waste material to a delivery container (10),
- e) said lid (2) having a plurality of fenestration couplings (4, 5),
- f) said delivery container (10) coupling with a lid (2) to dispose waste material (see figure 1, below).

Regarding the limitation directed to how the delivery container is made from converted supplies, product-by-process claims are not limited to the manipulation of the steps, only the structure implied by the steps. MPEP § 2113.

"[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted).

The structure implied by the process steps should be considered when assessing the patentability of product-by-process claims over the prior art, especially where the product can only be defined by the process steps by which the product is made, or where the manufacturing process steps would be expected to impart distinctive structural characteristics to the final product. See, e.g., *In re Garnero*, 412 F.2d 276, 279, 162 USPQ 221, 223 (CCPA 1979).

In the instant case, applicants have not recited any structure which positively distinguishes the claimed apparatus over the prior art.



Regarding claim 2, Rochat teaches an apparatus for disposing waste material in a converted container comprising:

a ) a material draw force (positive and negative pressure equalization, represented by arrows in figure 1),

b) a canister (1),

c) a bottle neck/throat plug (21) directing force to and away from a supply container (10),

d) a container (10) in the disposal chain,

e) a canister lid (2) having at least one fenestration (4, 5) constructed to connect to a supply container (10),

a composite draw path (10, 15 and 16) formed at least in part by the interior of a container.

Regarding the limitation directed to how the delivery container is made from a converted supply container, see the previous discussion of product-by-process claim interpretation.

Regarding claim 3, Rochat teaches an apparatus for converting supplies and reducing waste comprising,

a) a canister lid (2),

b) a draw path (10, 15, 16),

c) a canister body (1),

d) a bottle neck throat/pressure transfer plug (21),

e) a supply container (10) interposable between delivery and disposal,

f) a draw force directed by said path in part co-acting to transform a delivery container (10) to dispose waste material.

Regarding the limitation directed to the supply container being alternatively a supply container or a disposal container, the claim has no physical limitations which positively

distinguish the two types of containers. The examiner takes official notice of the fact that the bag of Rochat could contain either supplies or materials to be disposed of.

*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bogart whose telephone number is (571) 272-4933.

In the event the examiner is not available, the Examiner's supervisor, Larry Schwartz may be reached at phone number (571) 272-4390. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306 for formal communications. For informal communications, the direct fax to the Examiner is (571) 273-4933.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-3700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Michael Bogart  
22 February 2005



Larry I. Schwartz  
Supervisory Patent Examiner  
Group 3700